

Remarks:

1. Claim 18 is objected to because of several informalities. In response, claim 18 has been amended to overcome the objection.

2-3. Claims 16-17 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, claims 16-17 have been amended to remove the improper antecedent basis.

4-5. Claims 14, 16-18, 24-25 and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,430,375 (hereinafter the “‘375 Patent”) in view of U.S. Pat. No. 3,839,078 (hereinafter the “‘078 Patent”).

Present independent claim 14 recites a method for preparing a decorative laminate, comprising: a) providing décor paper with a pattern printed on a surface thereof, said printed pattern being adhered to said surface by a mordant; b) impregnating said décor paper with a thermosettable resin; and c) laminating the décor paper to a substrate.

The Official Action contends that the ‘375 Patent discloses every feature of claim 14, except where said printed pattern is adhered to said surface by a mordant. (Official Action, pg. 4). The Official Action then contends that the ‘078 Patent discloses that cellulosic substrates such as paper are impregnated with aluminum phosphate for various reasons, such as to improve the printability thereof. Specifically, the ‘078 Patent allegedly teaches that the aluminum phosphate solution can be applied to the substrate by either spraying or by impregnation. (Official Action pg. 4). The Official Action concludes that it would have been obvious to have modified the ‘375 Patent for making an abrasion-resistant laminate having printed paper by also coating or impregnating the paper with aluminum phosphate to improve the printability thereof. (Official Action, pg. 4). Applicants respectfully disagree.

When an application is submitted to the Patent and Trademark Office, statute¹ and case law² dictates that the burden of proof is on the PTO to establish a *prima facie* case of

¹ 35 U.S.C. 132.

obviousness.³ Once the *prima facie* case has been established, then the burden of going forward with the evidence to rebut the *prima facie* case shifts to the applicant.⁴ Only the burden of going forward with evidence to rebut shifts to the applicant, however. The burden of persuasion remains with the PTO.⁵ In this instance, a *prima facie* case would necessarily have to establish that the combined teachings of the '375 Patent with the '078 Patent provide a suggestion or motivation within the cited references to combine the cited references to arrive at the claimed invention.⁶ The suggestion or motivation to combine the references must not be a hindsight reconstruction of isolated disclosures within the prior art.⁷ Indeed, the lack of an appropriate motivation or suggestion to combine gives rise to an inference that the combination is the product of hindsight.⁸

There is no suggestion or motivation to combine the references as suggested by the Examiner. That the '078 Patent discloses that paper is impregnated with a mordant such as aluminum phosphate to improve the printability thereof does not provide a proper suggestion or motivation to combine the references to arrive at the method of claim 14 for preparing a decorative laminate. The '375 Patent discloses an abrasion-resistant laminate that explicitly comprises a "conventional printed paper." (See, for example, the Abstract and col. 5, lines 46-49 and col. 6, lines 53-55). The '375 Patent lacks any disclosure or suggestion that a problem existed with prior art laminates at the time of the '375 Patent to warrant the use of anything other than a "conventional printed paper" or

² See *In re Warner*, 154 USPQ 173, 178 (C.C.P.A. 1967); *In re Oetiker*, 24 USPQ 2d 1443, 1447 (Fed. Cir. 1992).

³ *In re Piasecki*, 223 USPQ 785, 788 (Fed. Cir. 1984).

⁴ *In re Carleton*, 202 U.S.P.Q. 165,168 (CCPA 1979).

⁵ *Ashland Oil v. Delta Resins and Refractories, Inc.*, 227 U.S.P.Q. 657, 659 (Cir. Fed. 1985). See also *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Cir. Fed. 1992): "In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. '[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.' The patent applicant may then attack the Examiner's *prima facie* determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness.".

⁶ *ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, 221 USPQ 929, 933 (Fed. Cir. 1984), "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can only be combined if there is some suggestion to do so."

⁷ *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992), "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention", quoting *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

⁸ *In re Rouffet*, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

some method of improving the printability of such “conventional printed paper.” Indeed, no part of the ‘375 Patent is directed to solving any type of problem with “conventional printed paper” at the time of the ‘375 Patent. On the other hand, there is no dispute that the ‘078 Patent discloses a method of coating various substrates, including paper, with a mordant such as aluminum phosphate. However, the ‘078 Patent fails to address any specific type of printing process for printed papers used in decorative laminates for which the aluminum phosphate could be used “to improve the printability thereof.” As a result, the stated motivation in the Official Action to combine the ‘375 Patent with the ‘078 Patent (i.e., “to improve the printability thereof”) does not constitute a proper suggestion or motivation to combine the teachings of the references, when the ‘375 Patent discloses solely the use of “conventional printed paper” and the ‘078 Patent fails to address any specific printing process that could be improved by the use of a mordant. Thus, it is submitted that the Examiner utilized classic hindsight reconstruction in choosing portions of isolated disclosures in the ‘375 Patent and the ‘078 Patent to attempt to arrive at the method of claim 14.

Further, present dependent claim 16 recites that the mordant is incorporated within an impregnating solution of the thermosettable resin, and the printed pattern is adhered to the surface of the décor paper by the mordant by impregnating the décor paper with a thermosetting solution containing the mordant.

A method for preparing a decorative laminate according to claim 14 that includes the feature of claim 16 of including the mordant in the thermosettable resin solution that impregnates the décor paper provides certain advantages. For example, incorporating the mordant into the resin avoids an additional and separate mordant treating step and a consequent drying or partial drying step, and is therefore less expensive operationally. (See the present application as filed, paragraph [0021].)

The ‘078 Patent, particularly at the cited location of column 17, line 60 to column 18, line 46, fails to disclose or suggest that the paper-impregnating mordant is included within a solution of a thermosetting resin. The ‘078 Patent discloses that the mordant alone impregnates the paper substrate, for example “*by spraying the solution on to the surface of the substrate or by immersing the substrate in a bath of the impregnant solution.*” (Col. 18, lines 26-29). The ‘078 Patent also teaches that the resulting mordant

impregnated substrate is then cured by heating, preferably for at least ten minutes, which in part serves to remove solvent. (Col. 19, lines 6-22). Thus, by requiring these additional steps of applying the mordant solution to the substrate and heating the mordant solution to cure (dry) the solution, the '078 patent teaches away from the present claimed invention of including the mordant within the thermosettable resin solution and its attendant advantages discussed above, which is evidence of the non-obviousness of dependent claim 16.

In light of the foregoing, including the cancellation of claims 24 and 28, it is respectfully submitted that the obviousness rejection of claims 14, 16-18, 24-25 and 28 is now moot, and that claims 14, 16-18 and 25 are in condition for allowance and should be passed to issuance.

6. Claims 14, 16-18, 24-25 and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over European Pat. Appl. No. 0 592 013 (hereinafter the “'013 Patent Application”) in view of the '078 Patent.

Present independent claim 14 recites a method for preparing a decorative laminate, comprising: a) providing décor paper with a pattern printed on a surface thereof, said printed pattern being adhered to said surface by a mordant; b) impregnating said décor paper with a thermosettable resin; and c) laminating the décor paper to a substrate.

The Official Action contends that the '013 Patent Application discloses every feature of claim 14, except where said printed pattern is adhered to said surface by a mordant. (Official Action, pg. 5). The Official Action then contends that the '078 Patent discloses that cellulosic substrates such as paper are impregnated with aluminum phosphate for various reasons, such as to improve the printability thereof. Specifically, the '078 Patent allegedly teaches that the aluminum phosphate solution can be applied to the substrate by either spraying or by impregnation. (Official Action pg. 5). The Official Action concludes that it would have been obvious to have modified the '013 Patent Application for making an abrasion-resistant laminate having printed paper by also coating or impregnating the paper with aluminum phosphate to improve the printability thereof. (Official Action, pg. 5). Applicants respectfully disagree.

Similar to the discussion in paragraphs 4-5 above, a *prima facie* case of obviousness would necessarily require that the combined teachings of the '013 Patent Application with the '078 Patent provide a suggestion or motivation within the cited references to combine the cited references to arrive at the claimed invention.⁹ The suggestion or motivation to combine the references must not be a hindsight reconstruction of isolated disclosures within the prior art.¹⁰ Indeed, the lack of an appropriate motivation or suggestion to combine gives rise to an inference that the combination is the product of hindsight.¹¹

There is no suggestion or motivation to combine the references as suggested by the Examiner. That the '078 Patent discloses that paper is impregnated with a mordant such as aluminum phosphate to improve the printability thereof does not provide a proper suggestion or motivation to combine the references to arrive at the method of claim 14 for preparing a decorative laminate. The '013 Patent Application discloses a decorative thermosetting laminate that comprises at least two patterned sheets of paper, where the paper can be patterned using either the rotary screen method or the photogravure printing method. (See, for example, page 5, lines 52-55; page 6, line 6, lines 41-42, lines 48-50). The '013 Patent Application merely states that these two printing methods may be used to provide the printed pattern on paper without giving any additional detail as to each method. This leads to the conclusion that both methods were known in the art at the time of the '013 Patent Application. The '013 Patent Application lacks any disclosure or suggestion regarding the method of printing the patterned sheets of paper to warrant the use of anything other than either the rotary screen method or the photogravure method. On the other hand, there is no dispute that the '078 Patent discloses a method of coating various substrates, including paper, with a mordant such as aluminum phosphate. However, the '078 Patent fails to address any specific type of printing process for printed papers used in decorative laminates for which the aluminum phosphate could be used "to

⁹ *ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, 221 USPQ 929, 933 (Fed. Cir. 1984), "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can only be combined if there is some suggestion to do so."

¹⁰ *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992), "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention", quoting *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

¹¹ *In re Rouffet*, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

improve the printability thereof.” As a result, the stated motivation in the Official Action to combine the ‘013 Patent Application with the ‘078 Patent (i.e., “to improve the printability thereof”) does not constitute a proper suggestion or motivation to combine the teachings of the references, when the ‘013 Patent Application discloses the use of conventional printing methods and the ‘078 Patent fails to address any specific printing process that could be improved by the use of a mordant. Thus, it is submitted that the Examiner utilized classic hindsight reconstruction in choosing portions of isolated disclosures in the ‘013 Patent Application and the ‘078 Patent to attempt to arrive at the method of claim 14.

Further, present dependent claim 16 recites that the mordant is incorporated within an impregnating solution of the thermosettable resin, and the printed pattern is adhered to the surface of the décor paper by the mordant by impregnating the décor paper with a thermosetting solution containing the mordant.

A method for preparing a decorative laminate according to claim 14 that includes the feature of claim 16 of including the mordant in the thermosettable resin solution that impregnates the décor paper provides certain advantages. For example, incorporating the mordant into the resin avoids an additional and separate mordant treating step and a consequent drying or partial drying step, and is therefore less expensive operationally. (See the present application as filed, paragraph [0021].)

The ‘078 Patent, particularly at the cited location of column 17, line 60 to column 18, line 46, fails to disclose or suggest that the paper-impregnating mordant is included within a solution of a thermosetting resin. The ‘078 Patent discloses that the mordant alone impregnates the paper substrate, for example “*by spraying the solution on to the surface of the substrate or by immersing the substrate in a bath of the impregnant solution.*” (Col. 18, lines 26-29). The ‘078 Patent also teaches that the resulting mordant impregnated substrate is then cured by heating, preferably for at least ten minutes, which in part serves to remove solvent. (Col. 19, lines 6-22). Thus, by requiring these additional steps of applying the mordant solution to the substrate and heating the mordant solution to cure (dry) the solution, the ‘078 patent teaches away from the present claimed invention of including the mordant within the thermosettable resin solution and its

attendant advantages discussed above, which is evidence of the non-obviousness of dependent claim 16.

In light of the foregoing, including the cancellation of claims 24 and 28, it is respectfully submitted that the obviousness rejection of claims 14, 16-18, 24-25 and 28 is now moot, and that claims 14, 16-18 and 25 are in condition for allowance and should be passed to issuance.

7. Claim 26 is rejected under 35 U.S.C. §103(a) as being unpatentable over the '013 Patent Application in view of the '078 Patent as applied to claim 25, and further in view of U.S. Pat. No. 6,685,993 (hereinafter the " '993 Patent"). Applicants respectfully disagree.

Nevertheless, as claim 26 ultimately depends from claim 14, which is patentable for at least the reasons set forth above, it is respectfully submitted that the obviousness rejection of claim 26 is now moot and should be removed, and that claim 26 is in condition for allowance and should be passed to issuance.

8-9. Claim 28 is rejected on the ground of non-statutory obviousness-type double patenting. In response, claim 28 has been cancelled

10. Claim 27 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The indication of the allowability of claim 27 is noted and appreciated.

Claim 27 has been amended into independent form, to include features of claims 14, 25 and 26. It is submitted that new independent claim 27 is allowable over the cited references, as none of the cited references disclose the features of claim 27 as originally filed, as admitted in the Official Action.

As applicant has traversed all of the rejections made by the Examiner, it is respectfully requested that the stated rejections and objections be withdrawn, claims 14, 16-18 and 25-27 be allowed, and the present application be passed onto issuance. No

additional fee is believed due with the present application. In the event a fee is due, please charge our Deposit Account No. 50-3381.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard H. Kosakowski", written over a horizontal line.

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